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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/858,389	05/19/97	FOERSTER	S A-1028CON

QM12/0815  
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NEW BRUNSWICK NJ 08933-7003

EXAMINER

KOO, B

ART UNIT	PAPER NUMBER
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3764

DATE MAILED:

08/15/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

08/858,389

Applicant(s)

FOERSTER ET AL.

Examiner

Benjamin Koo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- 1) ☒ Responsive to communication(s) filed on 15 May 2000.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1, 15-17, 35-37, and 43-45 is/are pending in the application.
- 4a) Of the above claim(s) 6 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 17 is/are allowed.
- 6) ☒ Claim(s) 1, 15, 16, 35-37, 43, and 44 is/are rejected.
- 7) ☒ Claim(s) 45 is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some \* c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) \_\_\_\_\_.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_

- 18) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1, 15, 16, 35-37, 43, and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Komiya, in view of Kirsch et al and Miller et al.. Komiya shows a device comprising: a discrete marker element (11), a member (10), a deployment actuator connector (10), a deployment actuator connector (15/16/21), a forming die (21b) wherein the marker element is able to travel along the tube, but does not show the cutting tip and the predetermined failure point. Komiya further describes the use of know delivery apparatuses, such as endoscopes, to place the device into proper position (column 2, lines 47-49). Applicant's summary discloses that the delivery apparatus may be any know type such as a tube, needle, cannula, trocar, etc... Miller et al. shows an implantable tissue marking device using a delivery apparatus which incorporates a needle or cutting edge. It would have been obvious to have used a needle as taught in Miller et al. because such a variation is an obvious art-recognized alternative, as even disclosed by the applicant, to serve the purpose of placing the marking device in the proper location in the body. Kirsch et al. shows a deployment actuator having a predetermined failure point. It would have been obvious to have used the deployment means of Kirsch et al. because both types would be considered art-recognized alternative structures. Both incorporate bendable marker elements which are similar in shape, but use different styles of deployment means, one using a notch,

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one breaking the marker off. Limitations drawn to various marker shapes or sizes are considered obvious choices of design based on user preference to suit a particular need or application.

***Response to Arguments***

3. Applicant's arguments filed 5/15/00 have been fully considered but they are not persuasive. It is believed that every element of the applicant's invention has been shown in the context of this rejection.

4. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it is believed that such motivation can be found in the knowledge generally available to a skilled artisan, as stated in the previous office action, such structures are art-recognized alternative known to one of ordinary skill.

5. In response to applicant's argument that the integration of the secondary deployment structure would destroy the function of the primary reference, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the

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test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

***Allowable Subject Matter***

6. Claim 17 is allowed.
7. Claim 45 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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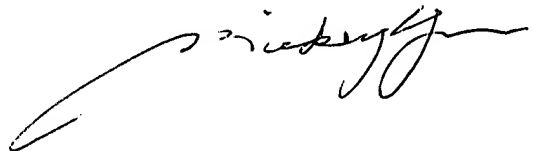
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin Koo whose telephone number is 703-308-2657. The examiner can normally be reached on M, T, W, & F; 9:30-7 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 703-308-2672. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-0758 for regular communications and 703-306-4520 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

bk  
August 2, 2000

Mickey Yu  
Supervisory Patent Examiner  
Group 3700

A handwritten signature in black ink, appearing to read "Mickey Yu", with a long, sweeping horizontal stroke extending to the left.